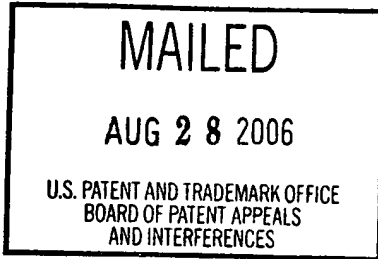


The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUHISA FUSHIHARA

Appeal No. 2006-2068
Application No. 09/854,693
Technology Center 3700

HEARD August 10, 2006

Before FRANKFORT, OWENS and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claim

1. For the reasons stated *infra* we will not sustain the examiner's rejection of claim 1.

THE INVENTION

The invention relates to a floating golf ball for use at a driving range, which has a good shot feel. Claim 1 is representative of the invention and is reproduced below:

1. A floatable golf ball for a driving range comprising a core and a cover covering the core, wherein
the cover has a flexural modulus (F) of 80 to 300 Mpa,

the golf ball has a specific gravity of not less than 0.5 and less than 1.0, and a deformation amount (D) of 3.0 to 6.0 mm when applying from an initial load of 98 N to a final load of 1275 N, and
a ratio (F/D) of the flexural modulus of the cover (F) to the deformation amount of the golf ball (D) is within the range of 24 to 31.

THE REFERENCE

The reference relied upon by the examiner is:

Yoshimasa et al. (Yoshimasa)

JP 06-327791

Nov. 29, 1994

THE REJECTION AT ISSUE

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Yoshimasa. The examiner's rejection is set forth on pages 2 and 3 of the Answer. Throughout the opinion we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellant and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103.

Appellant states, on pages 10 and 11 of the brief, that Yoshimasa teaches a two-piece golf ball, which floats. However, appellant argues, Yoshimasa does not teach or suggest a two piece golf ball where the ratio of flexural modulus of the golf ball cover (F) to the deformation of the golf ball (D) is within the range of 24 to 31.

In response the examiner states that Yoshimasa teaches a floating golf ball, which has all of the claimed characteristics except teaching the claimed range for the F/D ratio. See page 3 and table on page 4 of the Answer. On page 5 of the answer, the examiner further states:

The question before the BPAI is whether or not the ratio (F/D) from 24 to 31 is an obvious modification of the range 36 to 98 (Yoshimasa). And whether or not the claimed range from 24 to 31 is critical to the invention. Appellant's claimed range from 24-31 is not shown to be critical to the invention. Attention is directed to pages 6 - 7 of the instant specification, which recites, "When the ratio (F/D) is larger than 50, only the cover is too hard and stress applied to the core is large, and the core is easily cut ... Therefore it is desired for the F/D ratio to be within the range of not more than 50," Page 7 of the specification further recites, "When the ratio (F/D) is too small, the cover is soft, and the durability of the cover is degraded. Therefore it is desired for the ratio (F/D) to be within the range of not less than 15, ...". Appellant's specification makes clear the critical range necessary for the instant invention to perform properly is from 15 to 50.

We disagree with the examiner's rationale. Initially, we note pages 6 and 7 of appellant's specification, state that the most preferable upper and lower range for the F/D ratio are 31 and 24, thus we consider the desirability of the range to be established by the appellant's specification. In rejecting claims under 35 U.S.C. § 103 (a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial

burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and arguments.” *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444). In addition, our reviewing court stated in *In re Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433, that when making an obviousness rejection based on a combination, “there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant” (quoting *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)).

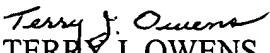
We do not find that the examiner has provided sufficient objective evidence to show that one skilled in the art would have modified Yoshimasa such that the F/D ratio of the balls would be between 24 and 31 as claimed. We do not consider appellant’s specification and the disclosed criticality of the range to negate the need for evidence. Appellant’s specification clearly demonstrates that at the time of filing of the invention appellant considered the range of F/D ratio between 24-31 to be the most preferable of those disclosed. The examiner carries the burden of providing objective evidence that a golf ball with such a range would be obvious to one of ordinary skill in the art the time of appellant’s invention. We do not find that the examiner has carried this burden and we will not sustain the examiner’s rejection of claim 1 under 35 U.S.C. § 103.

Conclusion

In summary, we will not sustain the examiners rejection of: claim 1 under 35 U.S.C. § 103 as being unpatentable over Yoshimasa. The decision of the examiner is Reversed.

REVERSED


CHARLES E. FRANKFORT
Administrative Patent Judge


TERRY J. OWENS
Administrative Patent Judge


ROBERT E. NAPPI
Administrative Patent Judge

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